

REMARKS/ARGUMENTS

I. Status of the Application

Prior to the entry of this Amendment, claims 1-17 were pending in this application. An office action mailed November 26, 2007 rejected claims 1-7¹ under 35 U.S.C. § 112, ¶ 2 as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The office action further rejected claims 1-5, 8-9, and 13-17 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,584,466 to Serbinis et al. (hereinafter "Serbins"); and claims 6-7, and 10 under 35 U.S.C. § 103(a) as being unpatentable over Serbinis, and further in view of U.S. Patent No. 6,434,580 to Takano et al. (hereinafter "Takano").

Claims 1, 6, 13 and 14 have been amended herein, and new claim 18 has been added, but no claims have been canceled. Therefore, claims 1-18 stand pending for examination after entry of this Amendment. Claims 1, 13 and 14 are independent claims. Applicant respectfully requests reconsideration of this application for at least the reasons presented below.

II. Claim Amendments

Claim 1 has been amended to recite "associating said first invention disclosure with a case data unit in said database, "associating, in said database, said patent application with said case data unit," "calculating, based on a filing date of said patent application, a first due date for filing said patent application in one or more foreign patent offices," "maintaining, in a docketing system on the server system, a record of one or more due dates associated with said case data unit, said one or more due dates comprising said first due date," and "sending, to said second client system, one or more docketing reminders pertaining to said first due date." Support for these amendments can be found throughout the application, including inter alia, in

paragraphs 46-49 and 69-77 of the specification. Claims 13 and 14 have been amended in somewhat similar fashion, although claim 13 does not add the first element described above.

Claim 13 has also been amended stylistically to replace the term "draft patent application" with the term "draft of a patent application" for enhanced clarity and to comport with the amendments described above. It is submitted that this stylistic amendment does not narrow the scope of claim 13.

Claim 6 has been amended for conformity with claim 1. It is submitted that this amendment does not narrow the scope of claim 6.

New claim 18 has been added. Support for this new claim can be found throughout the application, including inter alia, in paragraph 86 of the specification.

III. Rejections under 35 U.S.C. § 112

The office action rejected claims 1-17 under § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the office action asserted that claims 1, 13, and 14 have a limitation of "executing said first workflow rule from said server system to generate a message requesting approval from said second client system to prepare a patent application from said first invention disclosure and to communicate said message to said second client system."

These rejections are respectfully traversed.

As an initial matter, claim 14 does not include the element to which the Office Action objects, and the rejection under § 112, ¶ 2 therefore would seem not to apply to claims 14-17. Claim 1 clearly recites "executing said first workflow rule" Claim 1 further specifies that the workflow rule operates "to generate a message requesting approval from said second client system" and "to communicate said message to said second client system." Hence, what is being claimed by claim 1 is the execution of a workflow rule that does two things. First, it generates a

¹ Although the Office Action purports to reject only claims 1-7 under § 112, the Office Action describes purported deficiencies of claims 13 and 14 as well. Hence, it is believed that the Office Action may have been intended to reject claims 1-17 on these grounds.

message, and then it communicates (e.g., transmits) that message to the second client system. The claimed functionality is clearly recited by claim 1.

Claim 13 is similar, except that the generated message is for "requesting comments on said draft of said patent application." The claimed functionality of claim 13 is recited as clearly as that of claim 1.

It is difficult to see why one of skill in the art would not understand the scope of these elements. Nonetheless, if after reviewing the claim language in light of this explanation, the Examiner still is unable to understand the meaning of these elements, the Examiner is cordially invited to call undersigned counsel for a more thorough discussion of this issue.

IV. Rejections under 35 U.S.C. § 102

The office action rejected claims 1-5, 8-9, and 13-17 under § 102(e) as being anticipated by Serbinis. In the interest of expediting prosecution, claims 1, 13, and 14 have been amended as indicated above, and to the extent Serbinis might teach every element of prior claims 1, 13 and 14 (a proposition the applicants do not concede), it is respectfully submitted that Serbinis fails to teach or suggest the additional elements added by amendment herein.

As an initial matter, it is noted that Serbinis has nothing to do with the subject matter of any of the independent claims. The Office Action effectively ignores the elements of the pending claims, relying on the assertion that "the data identifying the document as relating to a patent application or invention disclosure or the content of the messages transmitted adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over prior art." Office Action, at 5. The applicants respectfully but vehemently disagree with this analysis. Under the Office Action's formulation, any computer-related invention could be reduced, ad absurdum, to the steps of transmitting messages and processing data, and no computer-related invention, therefore, could be patentable. This analysis flies in the face of established caselaw, including without limitation many of the cases upon which the Office Action relies.

Contrary to the Office Action's unsupported assertion, the nature of the documents and messages recited in claim 1 is functionally related to the claimed procedures. For example, even characterized broadly, claim 1 recites procedures for seeking approval to prepare a second document (a patent application) based on the content of the first document (the invention disclosure). Serbinis does not teach or suggest this. Moreover, there is an intimate relationship between an invention disclosure and a patent application, and the nature of the invention disclosed in the invention disclosure will certainly be of interest to the entity approving preparation of the patent application. Hence, not only is there a functional relationship between the documents, the messages, and the functional operations of claim 1, but Serbinis fails utterly to teach or disclose anything approaching this relationship.

Moreover, notwithstanding the impropriety of the Office Action's disregard of the existing elements of claim 1, the elements added by the present amendment highlight the functional relationship between the patent application and the recited operations. More to the point, the additional operations recited by the added elements are specific to the patent application process and rely on the nature of the documents (e.g., invention disclosure, patent application) recited in claim 1. Merely by way of example, claim 1 recites "calculating, based on a filing date of said patent application, a first due date for filing said patent application in one or more foreign patent offices." The nature of this calculation, which is specific to patent applications, cannot be considered nonfunctional descriptive material.

Further, neither Serbinis nor Takano appear to teach either these additional elements or many of the preexisting elements of claim 1, which the Office Action improperly ignores. Accordingly, claim 1 is believed to be allowable over any combination of Serbinis and Takano. For similar reasons, claims 13 and 14 are believed to be allowable. Claims 2-5, 8, and 9 each depend ultimately from claim 1, while claims 15-17 ultimately depend from claim 14; these dependent claims are believed to be allowable at least by virtue of this dependence. Reconsideration of the rejected claims is respectfully requested.

V. Rejections under 35 U.S.C. § 103

The office action rejected claims 6-7, and 10 under § 103(a) as being unpatentable over Serbinis, in view of Takano. As noted above, Serbinis fails to teach or suggest each element of claim 1. Takano, likewise, fails to teach these elements. Claim 1, therefore, is believed to be allowable over any combination of Serbinis and Takano. Claims 6, 7, and 10, each of which ultimately depend from claim 1, are believed to be allowable at least by virtue of this dependence.

VI. New claim 18

New claim 18, which depends from claim 1, and claim 18 is believed to be allowable at least by virtue of this dependence. Moreover, claim 18 further recites "receiving, at the server system, information about a payment status of an invention disclosure award pertaining to said patent application," and "displaying, for an inventor associated with said invention disclosure, an indication of a filing status of said patent application and an indication of said payment status of said invention disclosure award." It is believed that neither Serbinis nor Takano teaches or suggests the additional elements of claim 18. Claim 18, therefore, is believed to be independently allowable over any combination of Serbinis and Takano.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Appl. No. 09/996,077
Amdt. dated May 23, 2008
Reply to Office Action of November 26, 2007

PATENT

Dated: May 23, 2008

Respectfully submitted,

/Chad E. King/
Chad E. King
Reg. No. 44,187

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000 (Denver office)
Fax: 303-571-4321 (Denver office)

CEK:jep
61272451 v1